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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,271	10/13/2000	KENJI MIZUTANI	ERDP001	1202
20178	7590	06/16/2005	EXAMINER	
EPSON RESEARCH AND DEVELOPMENT INC INTELLECTUAL PROPERTY DEPT 150 RIVER OAKS PARKWAY, SUITE 225 SAN JOSE, CA 95134			VU, NGOC K	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/687,271

Applicant(s)

MIZUTANI, KENJI

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-22, 27, 30-38 and 44-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 and 44-60 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-17, 21, 22, 36 and 37 is/are rejected.
- 7) ☒ Claim(s) 9, 18-20, 27 and 30-35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/3/00</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: it appears that the term "devise" in line 12 is typographical error. Please change the term "devise" to "device".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 4, 5, 7 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 4, 5, 7 and 10-17 are indefinite because there is no antecedent basis for the limitation "said video encoded data file" in each claim.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 7, 8, 21, 22, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franco (US 20020046407 A1) in view of Asada (US 6,885,809 B1).

Regarding claim 1, Franco discloses a remote video recording and retrieve system comprising:

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a first computing device (remotely programmable video recording device/system) having access to a tuner (504), to a computer network (computer network 116), and to a video recording mechanism (video recording and replay module) (see figures 1, 5, 10 and [0089]-[0091]; and

a second computing device (user device) having access to said first computing device (remotely programmable video recording device/system) via said computer network (116) (see figures 1 and 10), and having access to a first data store (removable media, e.g., disc) remote from said first computing device (it is noted that the remotely programmable video recording device/system is configured to include a storage, e.g., a removable media drive such that the recorded content can be transferred onto removable media for use elsewhere. For example, the removable media, e.g., disc, can later be used at the user device, e.g., computer. From this view, the removable media is located remotely from the remotely programmable video recording device/system (see figures 1 and 10; [0153]), said second computing device being effective for submitting recording instructions (sending programming instruction 118 to the remotely programmable video recording device/system via the computer network 116) for recording a televised program (see [0064], [0065], [0085] and [0088] and figures 1 and 10);

said first computing device being effective for accessing and recording said televised program via said tuner and said recording mechanism (see [0091]), said first computing device being further effective for transferring a video encoded data version of said televised program to said first data store (the remotely programmable video recording device/system records an encoded video of television broadcast program on removable media – see [0153]-[0154]).

Franco does not specifically disclose the first computing device being effective for encoding a video signal into at least one predetermined video data encoding format. However, Asada teaches that a recording/playback device comprises an encoder for encoding video and

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audio signals from a tuner into compression-encoded data to be recorded onto a DVD RAM, and wherein the compression-encoding of video is performed in accordance with MPEG2 (see col. 15, lines 61-64; col. 16, lines 31-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Franco by including compression-encoding video and audio signals in MPEG2 format at the recording/playback device to record the compressed-encoded data onto the DVD RAM as taught by Franco in order to effectively maximize space in a storage or removable media for storing data.

Claim 2 calls for the recorded program on the removable media can be retrieved for playback (see Franco: [0153]).

Regarding claim 3, Franco teaches the computer network 116 is the Internet (see [0063]).

Regarding claim 7, Franco discloses the remotely programmable video recording device/system deletes content least recently viewed or recorded (see [0074], [0093], [0075]).

Regarding claim 8, Franco teaches that the removable media, e.g., disc, can later be used at the user device, e.g., computer. From this view, the removable media is located remotely from the remotely programmable video recording device/system (see figures 1 and 10; [0153]).

Regarding claim 21, Franco teaches providing a verification logon sequence for the user device prior to permitting access (see figure 2A, [0068], [0069], [0083]).

Regarding claim 22, Franco teaches the removable media is located remotely from the remotely programmable video recording device/system records broadcast content in accordance with the programming data, which may be one or more VCR-Plus codes. It is further noted that base upon the VCR-Plus code, the device/system determines the appropriate time

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and channel to record and records the broadcast content identified by the code (see [0006], [0106], [0081], [0092] and [0096]).

Regarding claim 36, Franco shows a web site through which the remotely programmable video recording device/system can be programmed including authorization verification prior to accepting any recording instruction from the user, displaying a list of scheduled televised program available for recording, e.g., TV guide online on web site, and making selection from listing causes the host system to transmit programming data to instruct the remotely programmable video recording device/system from the user device (see figures 2A-2C and [0068]-[0069]).

Regarding claim 37, Franco discloses that the user device is charged a service fee for every recording session (see [0116], [0125], [0127], [0153]).

***Allowable Subject Matter***

6. Claims 4, 5 and 10-17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Claims 9, 18-20, 27 and 30-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 38 and 44-60 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art, Franco (US 20020046407 A1) and Asada (US 6,885,809 B1) teaches a media recording apparatus and encoding feature, respectively. Specifically, Franco teaches instructing a recording device via computer network for recording broadcast content. Asada teaches that a recording device can perform encoding video and audio signals into

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compression-encoded data to be recorded onto a storage. Franco and Asada, either singularly or in combination, fail to anticipate or render the limitations "storing the resultant encoded data file in said data store, and transmitting said data file via said network access node to a predetermined destination on the Internet" obvious as recited in claim 38, and "using said second computing device to transmit said encoded digital representation to a predetermined destination via said computer network; and accessing said encoded digital representation from said predetermined destination location" as recited in claim 46.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hesselink et al. (US 6,732,158 B1) disclose a VCR webification system.

Terakado et al. (US 6,802,076 B1) disclose a method and apparatus of an electric transmission medium.

Haroun et al. (US 5,787,259 A) disclose digital interconnects of a PC with consumer electronics devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

June 7, 2005